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EXAMINER	
ORLANDO, MICHAEL N	

ART UNIT	PAPER NUMBER
1791	

NOTIFICATION DATE	DELIVERY MODE
05/29/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/550,148	DEMARS ET AL.	
	Examiner	Art Unit	
	MICHAEL N. ORLANDO	1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 May 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *26-50* is/are pending in the application.

4a) Of the above claim(s) *39-49* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *26-38 and 50* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

The arguments and amendments submitted 05/04/2009 have been fully considered, but the merits of the claims remain unpatentable over the prior art as set forth below.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 26-32, 36-38 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Washizaki et al. (EP 0547327A1).

Regarding claim 26, Washizaki discloses a method of applying a film to at least one side of a flat substrate via an apparatus (abstract, figure 1). The individual substrates are advanced to the film application unit and they are advanced along their plane (figure 1, reference 6 is the substrate). The film application unit, defined by the entire apparatus, consists of a reel for winding the film which has an axis perpendicular to the substrate feeding direction (figure 1, reference 2). The examiner notes that there is an intricate fitting of the invention of Washizaki which has numerous parts and sections which run parallel to the feeding substrate with two specific examples being the conveying section (reference 20) and the roller support members (reference 74). The unit of Washizaki further utilizes a leader of film being applied in strips to the passing substrate by the pressure rollers (reference 28) in contact with the substrate as it traverses, which unwinds the film from the reel (reference 2) as it is pulled down to the substrate. The blade (reference 62B) allows for cutting of the film to the appropriate length for application to the substrate and it can be seen that once the film for application is cut the trailing edge of the film (reference 1B) from the reel is still present and ready for application to either the next or same substrate as desired.

Washizaki does not explicitly state the width of the film is chosen as a function of the regions of the substrate to be covered by each film. Washizaki fails to teach the use of multiple film bands and multiple reels of film and selective localization of the films.

It would have been readily apparent (and therefore obvious) to an ordinary skilled artisan at the time of the invention that the thickness of the films being applied through the invention of Washizaki are defined by the thickness of the films on the reel and therefore the applied film thickness could have been readily modified to tailor the film application thickness with a predictable level of success merely by changing the thickness of the film on the reel. As to the use of multiple film bands being bonded and the use of multiple rolls of film such is merely a matter of obviousness. The courts have held that a mere duplication of essential working parts does not serve to patentably distinguish over the prior art *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). The issues in question are to the multiplication of the film rolls and the selective application thereof. First off, the film is known for providing a specific purpose to the substrate as provided above. An ordinary skilled artisan therefore would have been motivated to either duplicate and/or selectively locate the film to expectedly realize such functionality at desired locations on the substrate. As to the obviousness of selective localization, the courts have also established that merely rearranging parts of an invention involves only routine skill in the art. *In re Japikse,* 86 USPQ 70.

Regarding claim 27, the claimed method is merely a utilization of the apparatus of Washizaki. The method is primarily drawn to controlling the placement and advancement of the film bands relative to the substrate. Washizaki provides a feeding

reel of film (reference 2), film holders (reference 60), cutters (reference 62B) and pressure rollers for applying the leading edge of the film (reference 28). It would have been obvious to an ordinary skilled artisan seeking to tailor the placement of the film bands to merely manipulate the holding times and cutting locations Washizaki because as seen in figure 1, the cutting locations and feeding speeds would determine the length and placement of the strips.

Regarding claim 28, Washizaki discloses the generalized method except for duplicating the film feeding reels on either side of the substrate. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have duplicated the number of rolls on either side of the substrate, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. St. *Regis Paper Co. v. Bemis Co., 193 USPQ 8.* As to configuring the rolls so as the film can be overlapped such is merely a location of parts and it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse,* 86 USPQ 70. The solution to applicants particular problem, including more than one roll and configuring them to overlap, would have been readily apparent to an ordinary skilled artisan presented with Washizaki because clearly the width of the rolls define the width and placement of strips and in so desiring a second overlapping film one would have most reasonably included a second roll which overlapped in width to the first in order to produce an overlapped film application with predictable success.

Regarding claims 29 and 30, the direction of the feeding is merely a function of the orientation of the apparatus. With the apparatus positioned horizontally the film

feeds in a horizontal direction and with the apparatus positioned vertically, the film feeds vertically. There is nothing requiring the apparatus of Washizaki to be in either orientation and such is conceivably useable both ways. It would have been appreciated that the apparatus of Washizaki could merely be rotated 90 degrees to achieve a different feeding orientation.

Regarding claim 31, the method of Washizaki utilizes a tentative (i.e. partial) bonding, which is later pressured with rollers to completely apply (i.e. fully bond) (claim 2).

Regarding claim 32, Washizaki applied a light transmissible resin film (column 8, lines 35-40), which had been previously defined as being a protective film (column 1, lines 30-34).

Regarding claims 36-38, Washizaki discloses the claimed invention except for a computer optimizing means for applying the films strips. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilized up to date computer technology for optimizing the strip placement, since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner, 120 USPQ 192.* As set forth above, the placement of strips is clearly optimizable and tailorable for any desired film applying application and merely incorporating a computerized means for accomplishing such a task would have been within the purview of an ordinary skilled artisan since there is a desire in all arts to make things

computerized for reasons that include but are not limited to increasing speed and decreasing human error.

Regarding claim 50, the merits of the process have been addressed above. The sheet produced by the process is merely the inherently resultant product of feeding substrate though the apparatus of Washizaki.

5. Claims 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Washizaki et al. (EP 0547327A1), as applied to claim 26 above, and further in view of Tuor et al. (GB 2033947).

6. Regarding claims 33-35, Washizaki discloses a film applying apparatus for applying films to substrates as set forth above; however Washizaki does not explicitly teach the substrate as an automobile window that is curved.

Tuor, drawn to window covering films for automobiles, discloses a peelable functional film applied to an automobile windshield (figure 1). Automobile windshields are typically (if not always) defined by a radius of curvature, so therefore such would have been clearly obvious if not inherent given the nature of the windshields typically used in the manufacture of automobiles. It can be seen that the driver window is flat and does not possess the same radium of curvature that is typically found in windshields (figure 1).

It would have been obvious to one having ordinary skill in the art at the time of the invention to have used the method of Tuor with the apparatus of Washizaki because the combination of familiar elements (i.e. a film applying method being performed with a known film applying apparatus) is taken to be obvious when the combination does no

more than produces predictable results. It would have been obvious for an ordinary skilled artisan seeking to apply a film to a glass substrate, as in Tuor, to seek and utilize known techniques and apparatuses (such as that provided by Washizaki) for accomplishing such a task in quick and efficient manner. As to the location of strips, as set forth above, such would have been readily obvious to an ordinary skilled artisan presented with the apparatus of Washizaki. Also, as to the limitation of adding numerous strips and then cutting the individual windows from the larger sheet it is noted that as set forth above tailoring the strip placement is easily achievable with invention of Washizaki. Also, while neither of Tuor or Washizaki explicitly teach generating a larger product and then cutting into individually smaller products official notice is taken that it is commonly known across the art that when manufacturing sheet-like products they can either produced individually or cut from a larger a sheet and therefore it would have been obvious to an ordinary skilled artisan to select such a common practice as cutting from a larger sheet.

Response to Arguments

Applicant's arguments filed 05/04/2009 have been fully considered but they are not persuasive.

The applicant primarily contends that the inclusion of multiple bonded films and multiple reels of films applied to varying locations patentably distinguishes the instant invention from the prior art of record.

The examiner disagrees and notes that as set forth above the general method is known/obvious over the prior art. The issues in question the multiplication of the film rolls and the selective application thereof. First off, the film is known for providing a specific purpose (protection) to the substrate as provided above. An ordinary skilled artisan therefore would have been motivated to duplicate and/or selectively locate the film to expectedly realize such functionality at desired locations on the substrate. As to the obviousness of such a modifications, the courts have held that that a mere duplication of essential working parts (i.e. the number of film rolls) does not serve to patentably distinguish over the prior art *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Furthermore, the courts have established that merely rearranging parts of an invention involves only routine skill in the art. *In re Japikse,* 86 USPQ 70. In this case the difference in the prior art amounts to the types of modifications deemed by the courts as involving routine skill. Absent a showing of unexpected results the mere duplication and varying location of the film is taken to be an obvious modification that would have been made by an ordinary skilled artisan motivated to provide selective and/or increased protection (i.e. the function of the film set forth by the prior art).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL N. ORLANDO whose telephone number is (571)270-5038. The examiner can normally be reached on Monday-Thursday, 7:30am-4:30pm, alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip C. Tucker can be reached on (571) 272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MO

/Philip C Tucker/
Supervisory Patent Examiner, Art Unit 1791